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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,291	09/16/2003	Chaitanya Dev Sareen	60001.0272US01/MS 301788.	2618
7590	04/16/2007		EXAMINER	
Leonard J. Hope Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			LONG, ANDREA NATAE	
			ART UNIT	PAPER NUMBER
			2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/663,291

Applicant(s)

SAREEN ET AL.

Examiner

Andrea N. Long

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's Response

Claims 1-26 and 28-29 are currently pending. Claim 27 has been cancelled, claims 28 and 29 have been added and claims 1, 4, 8, 16, 18-23, and 26 have been amended. Claim 27 has been cancelled rendering the rejection under 35 U.S.C. § 101 moot. Claims 16 and 26 have been amended, but do not overcome the rejection under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16 and 26 recite the limitation "computer readable storage medium". In the specification the applicant discloses that a computer program product is equivalent to a computer readable medium. In addition the specification states, "the computer program product may also be a propagated signal on a carrier readable by a computing system and encoding a computer program of instructions for executing a computer process".

As such, electromagnetic signals are not considered to be statutory subject matter since it is not either process, machine, manufacture, or composition of matter {see the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" Annex IV(c)}.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tom Syroid et al. (Outlook 2000 In a Nutshell: A Power User's Quick Reference, published May 2000, pages 15 and 244-252) Herein after "Syroid" in view of Microsoft Outlook (2000), hereinafter "Outlook".

As to independent claim 1, Syroid discloses the *method for providing a user interface for defining an electronic message handling rule* (p. 245 [003], p. 246 Fig 6-14 → Syroid discloses rules for automated message handling in an email system), *the method comprising, receiving a request to create an electronic message handling rule* (p. 246 [004] [006] → Syroid discloses by selecting the Tools option to execute the Rules Wizard to create, modify or delete a rule); *in response to the request, identifying a context in which the request to create the electronic message handling rule was received* (p. 246 [004], Fig 6-14 → Syroid discloses a description is provided to give details on what the rule does); *and providing a user interface for defining the electronic message handling rule, wherein the contents of the user interface are customized based on the identified context* (p. 246 Fig 6-14 → Syroid displays a user interface which provides detailed rules). Syroid does not explicitly teach *the context*

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corresponding to a user selecting an electronic mail message. Outlook teaches a user selecting an electronic mail message (Figure 1 and 2) and while viewing the message (Figure 2 and 3) having the option of selecting an action to create a rule (Figure 3). When the action to create a rule is selected the context of the message is populated to create an condition based on the context of the message (Figure 4).

It would have been obvious to one skilled in the art at the time the invention was made to have combined the message handling of Syroid with the corresponding context of Outlook to provide the user a simple yet effective method for creating a handling rule without the required inputting of context by the user.

As to dependent claim 2, Syroid teaches wherein *the customized user interface for defining the electronic message handling rule comprises one or more user interface objects for defining one or more conditions for the rule and one or more user interface objects for defining one or more actions to be performed if the one or more conditions are satisfied* (p. 244 [002], p. 247 [007] → Syroid discloses that the message handling system uses conditions and actions to create a rule).

As to dependent claim 3, Syroid teaches wherein *one or more user interface objects for defining one or more conditions for the rule are a subset of all of the possible conditions for the rule* (Fig 6-17 → Syroid discloses in his figure that the conditions are grouped under a larger group of conditions).

As to dependent claim 4, Syroid teaches *wherein the context comprises the context of reading the electronic message* (p. 246 [005], p.249 [009] → Syroid discloses that the message handling system applies rules to incoming messages for the user to read).

As to dependent claim 5, Syroid teaches *wherein the one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the identity of a sender of the received electronic mail message* (p. 250 [013], p. 252 [018] → Syroid discloses that one of the conditions of setting a flag can be applied to a message sent from a specified individual).

As to dependent claim 6, Syroid teaches *wherein the one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on a subject of the received electronic mail message* (p. 250 [014], p. 252 [020] [022] → Syroid discloses that a condition could be based on content of a received message).

As to dependent claim 7, Syroid teaches *the one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the identity of one or more intended recipients of the electronic mail message* (p. 250 [015], p.252 [019] → Syroid discloses that conditions could be set for messages that are sent to specified individuals).

As to dependent claim 8, Syroid teaches *wherein the context comprises the context of creating the electronic mail message* (p. 252 [021] → Syroid discloses that messages sent which are created may set conditions based on specified words in the body of a message).

As to dependent claim 9, Syroid teaches the *one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the identity of the intended recipient of the created electronic mail message* (p. 250 [015] → Syroid discloses that conditions could be set for messages that are sent to specified individuals).

As to dependent claim 10, Syroid teaches the *one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on a subject of the created electronic mail message* (p. 252 [020] → Syroid discloses that messages sent which are created may set conditions based on specified words in the subject of a message).

As to dependent claim 11, Syroid teaches *the context comprises the context of creating an alert subscription* (p. 249 [011] → Syroid discloses wherein a condition could be set to notify when an important message arrives).

As to dependent claim 12, Syroid teaches wherein *the one or more conditions for the rule comprise receiving an alert electronic mail message generated as a result of the alert*

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subscription (p. 249 [011] → Syroid discloses that a user-specified notification message is displayed in reference to an important message alert).

As to dependent claim 13, Syroid teaches *wherein the context comprises the context of selecting a name* (p. 248 [008], p. 250 [013] → Syroid discloses selecting a name from the Rule Address subdialog).

As to dependent claim 14, Syroid teaches *wherein the one or more user interface object for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the selected name* (p. 250 [013] [015] → Syroid discloses that conditions could be set for messages that are sent to specified individuals).

As to dependent claim 15, Syroid teaches *wherein the one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on a subject of a received electronic mail message* (p. 252 [020] → Syroid discloses that a condition could be based on content of a received message).

As to dependent claim 16, Syroid teaches *a computer-readable storage medium comprising computer-readable instructions which, when executed by a computer, cause the computer to perform the electronic message handling rule of claim 1* (p. 15 [001] → Syroid discloses that a CD could be used to install the software of Outlook onto a computer's hard drive).

As to dependent claim 17, it's inherent to one skilled in the art that a computer-controlled apparatus capable of performing the method of claim 1 is present and needed to perform the functions of the software system.

As to independent claim 18, Syroid teaches *a contextually sensitive user interface for defining an electronic message handling rule* (p. 245 [003], p. 246 Fig 6-14 → Syroid discloses rules for automated message handling in an email system), *the user interface comprising, one or more user interface objects for specifying one or more conditions for the rule, the one or more user interface objects selected at least in part based upon a context in which a request to create the electronic message handling rule was received* (p. 246 [004], Fig 6-14 → Syroid discloses selection the Rule Wizard command from a user to create a condition for a incoming or outgoing message); *and one or more user interface objects for defining one or more actions to be performed if the one or more specified conditions are satisfied* (p. 244 [002], p. 247 [007] → Syroid discloses that the message handling system uses conditions and actions to create a rule). Syroid does not explicitly teach *the context corresponding to a user selecting an electronic mail message*. Outlook teaches a user selecting an electronic mail message (Figure 1 and 2) and while viewing the message (Figure 2 and 3) having the option of selecting an action to create a rule (Figure 3). When the action to create a rule is selected the context of the message is populated to create an condition based on the context of the message (Figure 4).

It would have been obvious to one skilled in the art at the time the invention was made to have combined the message handling of Syroid with the corresponding context of Outlook to

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provide the user a simple yet effective method for creating a handling rule without the required inputting of context by the user.

As dependent to claim 19, Syroid teaches *wherein the one or more user interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the identity of a sender of the electronic mail message when the context comprises the context of reading the electronic mail message* (p. 246 [005], p. 249 [010] [012] → Syroid discloses that conditions and actions can be set for incoming messages to read based on content of the message and the identity of the sender).

As to dependent claim 20, Syroid teaches *the one or more user inter interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on a subject of the electronic mail message when the context comprises the context of reading the electronic mail message* (p. 250 [014], p. 252 [020] → Syroid discloses that conditions and actions can be set for incoming messages to read based on content of the message).

As to dependent claim 21, Syroid teaches *the one or more user inter interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the identity of one or more intended recipient of the electronic mail message when the context comprises the context of reading the electronic mail message* (p.

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252 [019] → Syroid discloses that conditions and actions can be set for outgoing messages based on the intended receiver).

As to dependent claim 22, Syroid teaches *the one or more user inter interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the identity of the intended recipient of the electronic mail message when the context comprises the context of creating the electronic mail message* (p. 252 [019] → Syroid discloses that conditions can be set for messages created and being sent to an individual).

As to dependent claim 23, Syroid teaches *the one or more user inter interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on a subject of the electronic mail message when the context comprises the context of creating the electronic mail message* (p. 249 [009], p. 252 [020] → Syroid discloses the conditions could be set for messages that he user creates based on the content of the message).

As to dependent claim 24, Syroid teaches *the one or more user inter interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on the selected name when the context comprises the context of selecting a name* (p. 248 [008], p. 250 [013] → Syroid discloses that names can be selected from a database, with the selected names conditions can be set for that individual person or persons).

As to dependent claim 25, *Syroid one or more user inter interface objects for defining the one or more conditions for the rule comprise a user interface object for setting a condition for the rule based on a subject of a received electronic mail message when the context comprises the context of selecting a name* (p. 248 [008], p. 249 [010], p.252 [020] → Syroid discloses conditions can be based on incoming messages with specified content and from a specified person).

As to dependent claim 26, *Syroid teaches a computer-readable storage medium comprising computer-readable instructions which, when executed by a computer, cause the computer to perform the electronic message handling rule of claim 18* (p.15 [001] → Syroid discloses that a CD could be used to install the Outlook software onto a computer. The CD is the computer readable medium).

As to dependent claim 28, *Outlook teaches wherein identifying the context in which the request to create the electronic message handling rule was received comprises identifying the context in which the request to create the electronic message handling rule was received, the context corresponding to the user selecting the current message comprising a received message* (Figures 1-4 → Outlook teaches having the user select a message that was received and creating a handling rule based on the context of the message).

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As to dependent claim 29, Outlook teaches *wherein identifying the context in which the request to create the electronic message handling rule was received comprises identifying the context in which the request to create the electronic message handling rule was received, the context corresponding to the user selecting the current message* (Figures 1-4). While Outlook does not teach the message comprises a message ready to be sent, it is reasonable for one skilled in the art to include the action of setting handling rules based on the context of any message, sent or received to provide the user a simple yet effective method for creating a handling rule without the required inputting of context by the user.

Response to Arguments

4. Applicant's arguments with respect to claims 1 and 18 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment.

Amendment of the above independent claims to include the limitation of "the context corresponding to a user selecting an electronic mail message" significantly changes the scope of the claimed invention when interpreted as a whole and has necessitated new grounds of rejection.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea N. Long whose telephone number is 571-270-1055. The examiner can normally be reached on Mon - Thurs 6:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrea Long
04/10/2007

William S. Bashore
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PRIMARY EXAMINER